

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-7, 9-19, 21-25, and 28-32 are pending in this application. Claims 28, 30, and 31 are amended by the present amendment. As amended Claims 28, 30, and 31 are supported by the original claims, no new matter is added.

In the outstanding Official Action, Claims 1-7, 9-19, 21-25, and 28-32 were rejected under 35 U.S.C. §112, second paragraph; Claims 1-7, 9-12, and 28-32 were rejected under 35 U.S.C. §103(a) as unpatentable over Klein et al. (U.S. Patent No. 5,726,885, herein "Klein") in view of Steinberg et al. (U.S. Patent No. 6,628,325, herein "Steinberg"); and Claims 13-19 and 21-25 were rejected under 35 U.S.C. §103(a) as unpatentable over Klein in view of Steinberg and further in view of Shiota et al. (U.S. Patent No. 6,657,660, herein "Shiota").

With regard to the outstanding Office Action's assertion that the arguments in the response filed February 21, 2006 were improper based on *In re Keller*, it is respectfully noted that *In re Keller's* holding that "attacking references individually" is improper is based on an Applicant's argument that a cited reference did not include an element found in another of the references in a rejection under 35 U.S.C. §103. In the response filed February 21, 2006 (and the present response), arguments are presented that the Steinberg reference does not include an element that the outstanding Office Action asserts is taught or suggested by Steinberg. Accordingly, refuting such assertions is not "attacking the references individually" but in fact is responding to the rejection that has been made.

With regard to the rejection of Claim 1 under 35 U.S.C. §112, second paragraph, it is respectfully noted that Claim 1 recites "an image transmission method designating unit configured to designate ... server terminal information related to a method of transmission of input image data." The outstanding Office Action asserted that this function was an intended

use, and thus has little patentable weight. The outstanding Office Action then concluded that “If the Examiner has a reason to believe that the functional limitation can be performed by the prior art structure, the burden is on the applicant to prove otherwise.”

Initially, it is respectfully noted that even assuming *arguendo* that the features in question were intended uses, this still would not make the claims indefinite. Thus, it is respectfully submitted that Claims 1-19 and 21-25 are in compliance with all requirements under 35 U.S.C. §112, second paragraph.

In addition, it is respectfully submitted that the above-quoted features are *not* an intended use, but the recitation of a structural feature that is defined functionally. Well settled case law clearly supports the claiming of structural features using functional language. For example, *In re Schreiber* holds that features of an apparatus may be recited either structurally *or functionally*. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (Emphasis added.) See also MPEP §2114. Accordingly, the phrase “configured to” is used in a proper recitation of structural limitations that are defined functionally. Thus, Claim 1 recites proper structural limitations.

Finally, with regard to the statement that “If the Examiner has a reason to believe that the functional limitation can be performed by the prior art structure, the burden is on the applicant to prove otherwise,” it is respectfully submitted that the Examiner must provide some evidence that the cited art device can in fact perform the claimed function. Allegations that the cited art device *could* perform the function, (if modified to include structure that performs that function) does not present a *prima facie* case of obviousness, as it does not provide a reference that teaches or suggests the claim element in question.

With regard to the rejection of Claims 28-32 under 35 U.S.C. §112, second paragraph, Claims 28 and 30 are amended to recite “designating a method for transmitting an image captured by the information device used in the lending reservation method after the

information device is reconnected to the network” to clarify that the transmission of the image occurs after the information device is reconnected to the network. Claim 30 is amended to recite “transmitting the image to a remote printer and transmitting the image from the information device to the server.” Thus, it is respectfully submitted that Claims 28-32 are in compliance with all requirements under 35 U.S.C. §112, second paragraph.

With regard to the rejection of Claim 1 under 35 U.S.C. §103(a) as unpatentable over Klein in view of Steinberg, that rejection is respectfully traversed.

Claim 1 recites in part:

the client terminal comprises an image transmission method designating unit *configured to designate, at the time of reservation, server terminal information related to a method of transmission of input image data* once the information device is returned, wherein the input image data is an image captured by the information device and input from the information device to the server terminal, and
the server terminal transmits the input image data based on the method of transmission.

The outstanding Office Action conceded that there is no teaching or suggestion in Klein for “an image transmission method designating unit” as recited in Claim 1.¹ The outstanding Office Action cited Steinberg as describing “an image transmission designation unit configured to transmit an input image.”² However, it is noted that this description does not correspond to the claim language. Steinberg at most describes a digital camera 10 that can receive commands regarding data transmission. As there is no teaching or suggestion in Steinberg regarding making a reservation, Steinberg cannot teach or suggest a device configured to designate, *at the time of reservation*, a method of transmission of data. As noted above, Claim 1 recites a structural element that performs a certain function. As neither Klein nor Steinberg contain structural elements that performs the claimed function, neither Klein nor Steinberg teach or suggest “an image transmission method designating unit

¹See the outstanding Office Action at page 6, lines 4-6.

²See the outstanding Office Action at page 6, lines 8-10.

configured to designate, at the time of reservation, server terminal information related to a method of transmission of input image data” as recited in Claim 1.

Well settled case law holds that to establish *prima facie* obviousness of a claimed invention, ***all the claim limitations must be taught or suggested by the prior art***. In *re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). (Emphasis added). See also MPEP §2143.03. Therefore, as Klein and Steinberg do not teach or suggest each and every element of Claim 1, Claim 1 (and Claims 2-7, 9-12, and 32 dependent therefrom) is patentable over Klein in view of Steinberg.

As independent Claims 28 and 31 recite similar elements to Claim 1, Claims 28 and 31 (and Claims 29 and 30 dependent therefrom) are patentable over Klein and Steinberg for at least the reasons discussed above with respect to Claim 1.

With regard to the rejection of Claim 1 under 35 U.S.C. §103(a) as unpatentable over Klein in view of Steinberg and further in view of Shiota, that rejection is respectfully traversed.

Claim 13 recites in part:

the client terminal comprises an image transmission method designating unit ***configured to designate, at the time of reservation, server terminal information related to a method of transmission of input image data*** once the information device is returned, wherein the input image data is an image captured by the information device and input from the information device to the server terminal, and
the server terminal transmits the input image data based on the method of transmission.

The outstanding Office Action conceded that there is no teaching or suggestion in Klein for “an image transmission method designating unit” as recited in Claim 13. The outstanding Office Action cited Steinberg as describing “an image transmission designation unit configured to transmit an input image.”³ However, as noted above, the cited portions of

³See the outstanding Office Action at page 10, lines 10-20.

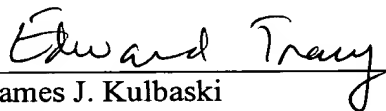
Steinberg at most describe a digital camera 10 that can receive commands regarding data transmission. There is no teaching or suggestion in Steinberg regarding making a reservation. Thus, Steinberg cannot teach or suggest a device configured to designate, *at the time of reservation*, a method of transmission of data. Consequently, it is respectfully submitted that Steinberg also does not teach or suggest "an image transmission method designating unit *configured to designate, at the time of reservation, server terminal information related to a method of transmission of input image data*" as recited in Claim 13. Further, it is respectfully submitted that Shiota does not teach or suggest this element either.

Consequently, as Klein, Steinberg, and Shiota do not teach or suggest each and every element of Claim 13, Claim 13 (and Claims 14-19 and 21-25 dependent therefrom) is patentable over Klein in view of Steinberg and further in view of Shiota.

Accordingly, in view of the present amendment, no further issues are believed to be outstanding and the present application is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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